

REMARKS

Claims 1-71 are currently pending in the application. Claims 1-71 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regards as the invention. Applicants respectfully traverse this rejection for the reasons set forth below.

The pending claims are not unreasonable in number

The Office alleges that, "[t]aken as a whole the claims recite an undue multiplicity of claims by virtue of the unreasonable number of claims presented would tend to obfuscate, confuse, and becloud the claimed invention." The Office relies upon the instruction in MPEP 2173.05(n) as basis for the rejection.¹

37 CFR 1.75(b) is clear in that "[m]ore than one claim may be presented provided they differ substantially from each other and are not unduly multiplied." Moreover, MPEP 2173.05(n) quotes *In re Chandler*,² which instructs that "applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. The rule of reason should be practiced and applied on the basis of the relevant facts and circumstances in each individual case."

For a 35 U.S.C. § 112, second paragraph, rejection to be proper in the present application, the present claims must not differ substantially from each other and must be unduly multiplied. The present application includes claims directed to several embodiments of the present invention. For example, certain claims are directed to a method for generating a price schedule, while others are directed to a system for

¹ Detailed Action, p. 2, ll. 5-13.

² *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963),

generating a price schedule. The claim sets directed to each of the embodiments differ substantially from one another because they are drawn to various embodiments of the present invention. For example, the claims drawn to a method for generating a price schedule differ substantially from those drawn to a system for generating a price schedule because the former are drawn to a method and the latter are drawn to a system. Moreover, no claim set drawn to a particular embodiment of the present invention includes more than 17 claims, which is certainly a reasonable number.

Accordingly, Applicants respectfully submit that, for at least these reasons, the rejection of claims 1-71 under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

The Office has no authority to limit the claims to a particular number

The Examiner indicates in the Office Action that “twenty-five (20) [sic] claims are sufficient to properly define applicants’ invention” and requires Applicants “to select certain claims, not to exceed twenty for examination on the merits of which no more than six are independent claims.”³ Applicants respectfully assert that the Office has no authority to specify a particular number of claims that are “sufficient to properly define applicant’s invention” or to require Applicants to limit their claims to a specific number of claims. Any such requirement by the Office is completely and utterly arbitrary. If, as the Examiner indicates, only 20 (or 25) claims are needed to sufficiently define Applicants’ invention, Applicants fail to understand why the Office accepts fees for claims in excess of 20 (or 25) claims. To suggest that a particular number of claims is sufficient to properly define Applicants’ invention, irrespective of the number of claims that most or few patents include, is directly counter to the instruction of the Court in *In re Chandler*. Applicants strongly, but respectfully, traverse any requirement by the Office to limit the claims in the present Application to a specific number as being baseless and without even a strand of merit. Accordingly, Applicants have not cancelled any claims in the present Application and, if need be, look forward to such a requirement being reviewed on appeal.

³ Detailed Action, p. 2, II. 9-12.

The “new excess claim fees” have no bearing on the reasonableness of the number of claims in the present Application

The Office Action notes “the new excess claim fees effective 12/8/04 as evidence of what is considered to be unreasonable.”⁴ The Office is reminded that the present Application was filed on 28 June 2001, which is over four years ago. Only recently have Applicants received a first Office Action, which is not an action on the merits. Applicants fail to understand how the excess claim fees today relate in any way to an application that has been pending for over four years. Accordingly, Applicants respectfully assert that the “new excess claim fees” have absolutely no bearing on the reasonableness of the number of claims in the present Application.

Moreover, Applicants fail to comprehend how excess claims in any application can be unreasonable merely due to the current excess claim fee structure. Under the current fee structure, Applicants pay considerable fees for claims in excess of the number included in the basic filing fee. It seems unreasonable for the Office to, on the one hand, charge substantial fees for excess claims and, on the other hand, allege that the same excess claims are unreasonable in number.

The burden for requiring restriction rests with the Office

The Office Action indicates that “it would appear that a multiplicity of inventions also appear to be involved and the applicants are requested to group their selection accordingly to read on a single invention. The applicant should group the claims according to what he believes to be distinct inventions that may be restricted in a subsequent action.”⁵ Applicants respectfully assert the pending claims are directed to one invention. If the Office believes otherwise, the burden rests with the Office to require restriction. Moreover, MPEP 814 instructs that the burden of indicating exactly how an application is to be restricted rests with the Office. Determining if more than one invention is present in an application is part of the Examiner’s duty during examination. Accordingly, Applicants

⁴ Detailed Action, p. 2, II. 21-23,

⁵ Detailed Action, p. 2, I. 24, through p. 3, I. 4.

respectfully decline the request to group the claims based upon a restriction criteria that, at the present time, can be known only to the Office.


CONCLUSION

The Applicant submits that all of the Examiner's rejections are hereby traversed and overcome. The Applicant respectfully submits that the Examiner has not shown by clear and convincing evidence that claims 1-71 are indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicants respectfully request withdrawal of the rejection of claims 1-17 and earnestly solicit an action on the merits in the very near future, as the present Application has been pending for more than four years without an action on the merits.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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